

REMARKS

The Office Action mailed on June 23, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-20 were pending in the present application. By this paper, Applicants do not cancel or add any claims. Therefore, claims 1-20 remain pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for the reasons that follow.

Rejections Under 35 U.S.C. §112, Second Paragraph

In the Office Action, claims 1 and 4 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office Action identified the use of the phrase "to realize" as unclear. As seen above, claim 1 has been amended, and Applicants respectfully request reconsideration.

Regarding claim 4, the Office Action did not cite a reason for rejecting this claim under 35 U.S.C. §112, second paragraph. Thus, Applicants assume that this rejection is in error, and respectfully request reconsideration. If the rejection was not in error, Applicants offer Examiner Salvatore a telephone interview with Applicants' representative at (202) 295-4747 to discuss this rejection.

Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Adriaensen (PCT/EP98/02980) in view of Daisel (JP 52126465). Applicants respectfully traverse the rejection as to the claims above, and submit that these claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action.

Lack of Suggestion or Motivation to Modify or Combine the References

Claim 1, the only independent claim of the invention, is primarily rejected based on the publication of Applicants' own prior efforts (both Mr. Adriaensen and Mr. Van DeWalle) advancing the field of reinforced canvas. As the Office Action correctly notes, Applicants previously identified (in the cited PCT application) that wires do not adhere well to a thermoplastic matrix material. Thus, Applicants previously directed their efforts towards utilizing cords, which, as they noted in the PCT application, have a higher adherence to thermoplastic matrix materials. That is, the primary reference teaches a suitable configuration for metal members that does not require an additional feature such as a primer that enhances adhesion of a thermoplastic matrix material to the metal. Thus, the cited PCT reference teaches away from the present invention because it identifies a problem and directs the skilled artisan to the use of cords to alleviate the problem.

Applicants respectfully submit that one of ordinary skill in the art, relying on the cited PCT application, would not look to modify the PCT application, but would simply follow the teachings of the PCT application and utilize metal cords. Such a modification to the teachings of the PCT application would only be undertaken by an innovator; a person who, when faced with a problem, ignores the solution to a problem placed directly in front of him or her (i.e., the use of cords) and instead seeks an alternative solution previously untested.

Still further, even if someone of ordinary skill in canvas reinforcement decided to completely ignore the specific teachings as to the remedy to the identified problem and

instead find a new solution, there is no evidence that such an artisan in 1999/2000 would look to techniques (in Daisel) involved in the construction of submerged fishing wire.

“[C]ommon sense” must be applied in deciding in which fields a person of ordinary skill would reasonably be expected to look. *Oetiker*, 24 U.S.P.Q.2d at 1446. In *Oetiker*, the Court found that “[i]t has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.” *Id.* In a similar fashion, a person of ordinary skill in the canvas arts would not reasonably look to the fishing line field.

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In the present case, Applicants have discovered, based on their continuing efforts to advance the field, that without the application of a primer layer to the metal members, the thermoplastic material disposed around the metal members flows away during welding of the strip to the canvas, sometimes resulting in a metal member that is no longer surrounded by the thermoplastic material after welding; increasing the susceptibility of the metal to corrosion. (See specification, page 3, first paragraph.) This problem is simply not identified in the prior art.

Claim 16

Claim 16 stands rejected based on the combination of the above cited references against claim 1, and Carey II (USP 5,489,490), which is relied on in the Office Action to teach a metal member coated with a zinc layer or with a zinc alloy layer.

The Office Action appears to rely on the alleged ease by which the references can be combined, contrary to the procedures stipulated in the MPEP. The MPEP specifically states that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (MPEP § 2143.01, subsection 3, first sentence, citations omitted.)

Also, the Office Action appears to suggest that there is a need to make fabric canvass reinforcements which are highly resistant to corrosion by coating a metal layer with zinc or a zinc alloy. However, there is nothing in any of the cited references that teaches or suggests such a need.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained above), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As a preliminary matter, claims 7-13, 15, 16 and 18 were rejected on the grounds that it “has been held that the functional ‘whereby’ statement does not define any structure and accordingly cannot serve to patentably distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 37 (1957).” Applicants respectfully submit that the PTO is misconstruing the claims of the present invention as well as the current status of the law.

First, Applicants note that the language following the term “whereby” is not functional language, as opposed to the language of the claims of *In re Mason*. For example, the recitation that “said metal member is a steel wire with a carbon content of at least 0.40%” of claim 13 is not functional language; it is structural language. Just because language of a claim follows the term “whereby” does not mean that the language is functional. Still further, *In re Mason* is completely silent in regard to even a hint that the language following the term “whereby” automatically means that the language should be ignored in determining patentability. The cited case simply does not stand for the position presented in the Office Action, and thus the recitations following the term “whereby” should have been considered in preparing the Office Action.

Second, even if the language was indeed functional as proffered in the Office Action, the only case that has ever cited *In re Mason* (to the best of Applicants’ knowledge) states that: “the idea that functional language ipso facto cannot precisely define novelty in structure

was laid to rest in *In re Swinehart*, 439 F.2d 210, 58 C.C.P.A. 1027, 169 U.S.P.Q. 226 (1971).” *Plastic Container Corp., vs. Continental Plastics of Oklahoma*, 607 F.2d 885, 907 (Fed. Cir. 1979). Thus, the language following the phrase “whereby” should have been considered for yet another reason.

Still, in the interest of advancing prosecution, Applicants have made the above non-limiting amendments to the claims to change the term “whereby” to “wherein.” Thus, the language following the term “wherein” should be considered in determining the patentability of the present invention, and, as will now be discussed, serves to differentiate the present invention from the prior art.

Claims 4 and 6

Claim 4 recite that the “primer layer comprises a hot melt,” while claim 6 recites that the “primer layer comprises a bifunctional silane compound.” Applicants respectfully submit that Daisel does not teach or suggest either of these elements. While Daisel does teach a primer, the reference does not teach a primer comprising a hot melt or a bifunctional silane compound. Indeed, Daisel teaches away from this element, as the primer of Daisel “may be PVC, epoxy-phenol, polybutadiene dissolved in organic solvent.” (Daisel abstract.) The primer of Daisel, after application, is passed through a heater to cure the primer. Adriaensen, as admitted in the Office Action, does not teach a primer, and thus cannot remedy the deficiencies of Daisel.

Claim 12

Claim 12 recites that the “metal member is a wire with a rounded I-profile.” Applicants respectfully submit that neither of the cited references teach or suggest this element, and thus claim 12 is allowable for at least this reason.

Claim 13

Claim 13 recites that the “metal member is a steel wire with a carbon content of at least 0.40%.” (Emphasis added.) The Office Action states that Adriaensen teaches that suitable “metal materials include steel, copper or a low carbon steel wire with a carbon content below .4%. (Page 5, 6-15).” (Office Action, page 3, lines 1-2, emphasis added.)

Thus, Adriaensen fails to teach this element, and in fact teaches away from claim 13. Claim 13 is allowable for at least this reason.

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In sum, even if the first requirement of MPEP § 2143 is satisfied (which it is not), the third requirement of MPEP § 2143 is not satisfied in the Office Action, at least in regard to at the above claims, since the cited references, alone or in combination, do not teach or suggest each and every element of these claims.

Any Next Office Action Should Be A Non-final Office Action

Applicants respectfully submit that since claims 7-13, 15, 16 and 18 were not properly examined based on a misapplication of the law, any next office action should be a non-final office action, as Applicants' amendments to the claims to remove the term "whereby" do not constitute an amendment that changes the scope of the claims or otherwise requires a new art search, for the reasons discussed above.

Conclusion

Applicants believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Salvatore is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date Sept 23 2003

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